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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,479	09/04/2003	Jonathan Helitzer	HSDO-P01-003	8693
28120 7590 02/12/2008 ROPES & GRAY LLP PATENT DOCKETING 39/41 ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/656,479

Applicant(s)

HELITZER ET AL.

Examiner

Natalie A. Pass

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23, 25, 27-31, 39, 42-44, 47 and 50-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23, 25, 27-31, 39, 42-44, 47 and 50-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2 November 2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 November 2007 has been entered.
2. This communication is in response to the Request for Continued Examination and the amendment filed on 2 November 2007. Claims 1-22, 24, 26, 32-38, 40-41, 45-46, 48-49 have been cancelled. Claims 23, 25, 39, 44, 47 have been amended. Claims 50-57 have been newly added. Claims 23, 25, 27-31, 39, 42-44, 47, 50-57 remain pending. The Information Disclosure Statement filed 2 November 2007 has been entered and considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 23, 25, 27-31, 39, 42-44, 47, 50-57 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Newly amended claims 23, 39, 44, 47 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- "based on data output electronically by the incorporated technology," as disclosed in claims 23, 39, 44 at lines 9, 9, 11, respectively;
- "determining, using the computer system, an alteration to a premium for the insurance policy based on the condition of the building indicated in the monitoring data," as disclosed in claim 23, lines 11-12; and
- "determining an alteration to a premium for the insurance policy based on the condition of the building structure indicated in the monitoring data," as disclosed in claim 47, lines 11-12.

(B) Claims 25, 27-31, 42-43, 50-57 incorporate the features of independent claims 23, 39, 44, 47, through dependency, and are also rejected.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 4 September 2003. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 4 September 2003.

6. Newly added claims 54-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 54-55 recite "the method of claim 44" in the preamble, however claim 44 recites a system. As such, it is unclear whether applicant seeks patent protection for a method or for a system. Please note MPEP section 2106. For the purpose of finding art, Examiner interprets the claims to recite a system.

(B) Claims 56-57 recite "the method of claim 47" in the preamble, however claim 47 recites a system. As such, it is unclear whether applicant seeks patent protection for a method or for a system. Please note MPEP section 2106. For the purpose of finding art, Examiner interprets the claims to recite a system.

7. The rejection of claims 23, 39, and 41 under 35 U.S.C. 112, second paragraph, for insufficient antecedent basis is hereby withdrawn due to the amendment filed 2 November 2007.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 23, 25, 27-31, 39, 42-44, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prendergast et al., U.S. Patent Number 5, 842, 148, in view of Farmer, U.S. Patent Application Publication Number 2004/0139034.

NOTE: The following rejections assume that the subject matter added in the 2 November 2007 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 3-5 above in the next communication sent in response to the present Office Action.

(A) Claims 23 and 39 have been amended to include the recitation of

- ♦ "[...] obtaining monitoring data, by the insurance company, indicating a condition of the building, based on data output electronically by the incorporated technology [...]," at lines 8-9 and 8-9, respectively;
- ♦ "[...] inputting the monitoring data into a computer system [...]," at lines 10 and 10, respectively; and
- ♦ "[...] determining, using the computer system, an alteration to a premium for the insurance policy based on the condition of the building indicated in the monitoring data [...]," at lines 11-12 and 11-12, respectively;
- ♦ "[...] altering the premium of the issued insurance policy based on the determination [...]," at lines 11-12 and 11-12, respectively.

As per newly amended claims 23 and 39, Prendergast teaches a method for insuring, and a method for insuring by an insurance company, a building structure by taking into account technologies that militate against loss comprising the steps of:

maintaining a database identifying a plurality of technologies that reduce risk of loss to an associated building structure (Prendergast; column 2, lines 29-34); and

wherein the incorporated technology is capable of outputting data electronically; Examiner interprets Prendergast's teachings of "the original collected structural data is preserved in permanent electronic form usable by program 40" (Prendergast; column 7, lines 17-21) to teach a form of wherein the incorporated technology is capable of outputting data electronically.

Although Prendergast teaches “insurance carriers... may decide to give structures getting a favorable rating much lower insurance rates” (Prendergast; column 6, line 58 to column 7, line 2), and “a type of database related software that is becoming more and more useful to insurance and reinsurance industries to evaluate portfolios of insurance policies for actuarial purposes. In addition, lenders of all types are starting to utilize this type of database and related software in their loss reduction and risk analysis efforts” (Prendergast; column 5, lines 39-45), and “a reliable, quantified risk rating that can be used by insurance companies to make decisions regarding offering of insurance and rates of insurance” (Prendergast; Abstract), Prendergast fails to explicitly disclose

issuing an insurance policy by an insurance company, covering a building structure that incorporates a technology from the plurality of technologies identified in the database;

obtaining monitoring data, by the insurance company, indicating a condition of the building, based on data output electronically by the incorporated technology;

inputting the monitoring data into a computer system;

determining, using the computer system, an alteration to a premium for the insurance policy based on the condition of the building indicated in the monitoring data; and

altering the premium of the issued insurance policy based on the determination.

However, these features are well-known in the art as evidenced by Farmer.

In particular, Farmer teaches a method comprising

issuing an insurance policy by an insurance company, covering a building structure that incorporates a technology from the plurality of technologies identified in the database (Farmer; paragraph [0001], [0011]-[0012], [0044]);

obtaining monitoring data, by the insurance company, indicating a condition of the building, based on data output electronically by the incorporated technology (Farmer; paragraph [0026]);

inputting or “capturing” the monitoring data into a computer system (Farmer; paragraph [0026]);

determining, using the computer system, an alteration to a premium for the insurance policy based on the condition of the building indicated in the monitoring data (Farmer; paragraph [0026]); and

altering the premium of the issued insurance policy based on the determination (Farmer; paragraph [0026]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Prendergast to include these limitation, as taught by Farmer, with the motivations of “provid[ing] the ability to monitor the user or environment to allow the capture of data, which can be communicated to an electronic marketplace to calculate the cost of related products or services to the user within such an environment” and “for monitoring various types of information relating to the operation of vehicles, building systems, or monitoring of other personnel or environments ... [and] ... for communicating information ... [...] ... to the insurance company providing ... [...] ... insurance coverage” (Farmer; paragraphs [0001], [0011]).

(B) As per claims 25, 27-31, 42-43, Prendergast and Farmer teach a method as analyzed and discussed in claims 23 and 39 above

wherein the monitoring data indicates the functional status of the incorporated technology (Farmer; paragraphs [0012], [0017], [0029]);

wherein the data output by the incorporated technology is output over a communications network (Farmer; Figure 3, Items 52, paragraph [0027]);

wherein the data output by the incorporated technology is output via “wireless communication” (reads on “a broadcast transmission” (Farmer; paragraph [0027]);

wherein the incorporated technology comprises a risk mitigation technology (Farmer; paragraph [0026]);

wherein the technology comprises a risk militation technology (Farmer; paragraph [0026]); and

comprising receiving, by the “carrier” (reads on “insurance company”), the data output by the incorporated technology (Prendergast; Abstract, column 6, line 58 to column 7, line 2), (Farmer; paragraphs [0026]-[0027]).

The motivations for combining the respective teachings of Prendergast and Farmer are as given in the rejection of claim 23 above, and incorporated herein.

(C) Amended claim 44 differs from method claim 23, in that it is a system rather than a method for insuring a building structure by taking into account technologies that militate against loss.

System claim 44 repeats the subject matter of claim 23, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 23 have been shown to be fully disclosed by the collective teachings of Prendergast and Farmer in the above rejection of

claim 23, it is readily apparent that the system disclosed collectively by Prendergast and Farmer includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 23, and incorporated herein.

(D) Claim 47 differs from method claim 23, in that it is a system rather than a method for insuring a building structure by taking into account technologies that militate against loss, and by reciting a “server associated with an insurance company...” in line 5.

As per this limitation, Prendergast clearly discloses his invention to be implemented on a “server ... [...] ... ” (Prendergast; column 2, line 29 to column 3, line 29); Examiner interprets Prendergast’s teachings of “data is input into a database usable by a probabilistic engine computer program. This program generates an estimate of the risk of damage to the structure ... [...] ... This risk determination can be converted into a standardized “rating” that can be used by homeowners, insurance companies, etc.” to be a form of a “server associated with an insurance company...”. The remainder of claim 47 repeats the limitations of claim 23, and is therefore rejected for the same reasons given above for claim 23.

(E) As per newly added claims 50-57, Prendergast and Farmer teach a method and system as analyzed and discussed in claim 23, 39, 44, and 47 above

wherein the premium alteration determination is further based on information stored in the “aggregated data” (reads on “database”) about the incorporated technology that electronically output the data on which the monitoring data was based (Farmer; paragraphs [0030], [0034]-[0035]); and

wherein the insurance policy includes an attachment point, and the premium alteration determination is further based on the attachment point (Farmer; paragraph [0034]); Examiner interprets Farmer's teachings of "premium ranges based upon the information" (Farmer; paragraph [0034]) to be a form of "wherein the insurance policy includes an attachment point, and the premium alteration determination is further based on the attachment point."

The motivations for combining the respective teachings of Prendergast and Farmer are as given in the rejection of claim 23 above, and incorporated herein.

Response to Arguments

10. Applicant's arguments on pages 7-9 of the response filed 2 November 2007 with respect to claims 23, 25, 27-31, 39, 42-44, 47, 50-57 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Carfi, et al., U.S. Patent Application Publication Number 20030135395, Underwood et al., U.S. Patent Number 5873066, Loucks et al., U.S. Patent Number 7114376, Dillard, U.S. Patent Application Publication Number 2005/0086084, and the article teach the environment of reducing insurance risk.

Portable structure tester may bring better-built homes, shopping malls, skyscrapers. 1999. [Retrieved on 23 January 2008]. Retrieved from Internet.URL:
<http://www.sandia.gov/LabNews/LN01-29-99/ascer_story.htm>.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

Art Unit: 3626

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/NAP/

Examiner, Art Unit 3626

January 27, 2008

/C. Luke Gilligan/

Primary Examiner, Art Unit 3626